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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,243	06/26/2003	Tetsuo Hasegawa	04329.3080	4233

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EXAMINER
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HARPER, LEON JONATHAN

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/606,243	<b>Applicant(s)</b> HASEGAWA ET AL.	
	<b>Examiner</b> Leon J. Harper	<b>Art Unit</b> 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/6/2006</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed 4/6/2006 has been entered. Claims 1-11 have been amended. Claims 1-15 are pending in this office action.

### ***Claim Rejections - 35 USC § 102***

Claims 1-3,6-8,11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2003 0065774 (hereinafter Steiner).

2. As for claim 1, Steiner discloses: a temporary search unit configured to, when receiving from an agent a search request to search for a desired information service from a plurality of information services existing on a network, search a registry in which said plurality of information services are registered in such a manner that said plurality of information services correspond to information items and item values corresponding to the contents of each service (See paragraph [0027] and table 2 agent =requestor, database of resources are maintained by the resource broker ); and search condition item extracting means for extracting at least one of an information item related to the information service retrieved by the temporary search unit and a value of the information item, from the registry and notifying the agent of at least one of the information item extracted and the value extracted, together with the result of the search made by the temporary search unit (See paragraphs 0039-0041).

As for claim 2, Steiner discloses: wherein the search apparatus condition item extracting means classifies, common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit and notifies the agent of the result (See paragraphs 0041 and 0076).

As for claim 3, the rejection of claim 2 is incorporated, and further Steiner discloses: wherein the search condition item extracting means uses ontology trees to classify, by common category, the information item names and/or item values related to the information service retrieved by the temporary search unit (See table 3 and paragraph 0088 note that Resource Description is a category name and List of resources has properties of each resources, also note paragraph 0086).

3. Claims 6-8 are information service support claims corresponding to information service search support claims 1-3 respectively, and are thus rejected for the same reasons set forth in the rejection of claims 1-3.

Claims 11-13 are information service search method claims corresponding to information service search support claims 1-3 respectively, and are thus rejected for the same reasons set forth in the rejection of claims 1-3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4,5,9,10,14,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner as applied to claim 2 above, and further in view of US 6327590 (hereinafter Chidlovskii).

4. As for claim 4, the rejection of claim 2 is incorporated, and further Steiner differs from the claimed invention in that Steiner does not explicitly disclose: wherein the

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search condition item extracting means classifies, by the frequency of appearance, the information item names and/or item values classified by category and notifies the agent of the result. Chidlovskii however does disclose the search condition item extracting means classifies, by the frequency of appearance, the information item names and/or item values classified by category and notifies the agent of the result (See column 1 lines 41-44). It would have been obvious to an artisan of ordinary skill in the pertinent art at the time the invention was made to have incorporated and teaching of Chidlovskii into the system of Steiner. The modification would have been obvious because the more an information item name appears; the assumption is the more vital that item is to the operations of the provider. This statement is not one of conclusion. An artisan skilled in the art must use the phrase the assumption is or something similar because frequency of appearance is not the most accurate method of classification but is nevertheless implemented because it is one of the easiest, with both heap and bubble sort having modifications that use a frequency sort

As for claim 5, the rejection of claim 4 is incorporated, and further Steiner differs from the claimed invention in that the search condition item extracting means determines the qualification as a search condition item of each of the information item names and/or item values classified by the frequency of appearance for a search condition, on the basis of its frequency of appearance and notifies the agent of the result is not explicitly indicated. Chidlovskii however does disclose: wherein the search condition item extracting means determines the qualification as a search condition item

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of each of the information item names and/or item values classified by the frequency of appearance for a search condition, on the basis of its frequency of appearance and notifies the agent of the result (See column 9 lines 46-51). It would have been obvious to an artisan of ordinary skill in the pertinent art to have incorporated the teaching of Chidlovskii into the system of Steiner. The modification would have been obvious because the more an information item name appears; the assumption is the more vital that item is to the operations of the provider.

Claims 9 and 10 are information service support claims corresponding to information service search support claims 4 and 5 respectively, and are thus rejected for the same reasons set forth in the rejection of claims 4 and 5.

Claims 14 and 15 are information service search method claims corresponding to information service search support claims 4 and 5 respectively, and are thus rejected for the same reasons set forth in the rejection of claims 4 and 5.

### ***Response to Arguments***

Applicant's arguments filed 4/6/2006 have been fully considered but they are not persuasive.

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Applicant Argues:

With regard to claim 1, Steiner fails to teach at least “search condition item extracting means” as claimed. According to Steiner, “resource providers are the nodes that have access to various resources.’ Steiner, ¶ 0027. Finding an appropriate node having access to a particular resource included in a query and sending the query to that node as disclosed by Steiner, does not constitute means for extracting at least one of an information item related to the information service retrieved by the temporary search unit and a value of the information item, from the registry and notifying the agent of at least of the information item extracted and the value extracted, together with the result of the search made by the temporary search unit, ‘ as recited in claim 1. Obtaining a resource provider having access to a resource is not that same as extracting information items and/or item values registered corresponding to services searched at a temporary search unit. Indeed, neither the relied-upon portion nor any other portion of Steiner teaches the claimed “search condition item extracting means.”

Examiner Responds:

Examiner is not persuaded. Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. During patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’ Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.



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In re Prater, 162 USPQ 541,550-51 (CCPA 1969). Steiner discloses a search architecture (See title). In accordance with the title Steiner does more than just find a node with access to a particular resource. Steiner discloses brokers that register available resources and coordinate searches on the network (See Steiner paragraph 0024) Steiner discloses a requester which makes a request to a search broker. (See paragraph 0027). The requester makes this request by sending a "Resource description" which is a data type (See table 1). The search broker must extract the information contained within the Resource description data type in order to search based upon inter alia a description of the resource. Moreover, the Resource query data type also contains search terms which must be extracted as they are sent from requester to search broker and from search broker to resource provider (See paragraph 0029).

Applicant Argues:

Further, Steiner does not teach at least search condition item extracting means that classifies, by, common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit and notifies the agent of the result as recited in claim 2. Steiner's disclosure of delivering and caching search results does not constitute classifying information item names and/or item values.

Examiner Responds:

Examiner is not persuaded. While caching alone does not constitute classifying by common category, the caching was citing to illustrate a separating technique to show that the prior art encompassing many ways to separate the information item names and/or item values. However, the registerResourceProvider does classify the information item names and/or values into common categories (See paragraph 0076). This classification is better illustrated in table 3 in which you can see the categories travel, home loan, auto loan etc. and their respective mapping indexes (See Table 3).

Applicant Argues:

Additionally, Steiner does not teach at least "search condition item extracting means that uses ontology trees to classify, by common category, at least one of the information item names and the item values related to the information service retrieved by the temporary search unit" as recited in claim 3.

Examiner Responds:

Examiner is not persuaded. Steiner discloses: Using any suitable database for registration purposes. (See paragraph 0086). Steiner also discloses using a decision tree to implement the resource providers. (See paragraph 0086). A decision tree is a type of ontology tree given the relationship test of an ontology tree. Once the Resource

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providers are implemented using decision trees, the common categories in table 3 will be based upon ontology trees.

Applicant Argues:

In this case, The office Action does not show, by "clear and particular" evidence that a skilled artisan considering Steiner and Chidlovskii, and not having the benefit of Applicants' disclosure, would have been motivated to modify or combine the references in a manner resulting in Applicants' claimed invention. The Examiner alleged that a skilled artisan would have combined the references "because the more an information item name appears the assumption is the more vital that item is to the operations of the provider." This conclusory allegation in the office Action is not properly supported and does not establish a motivation or suggestion for combined the reference as alleged or in a manner resulting in the invention defined by applicants claims. In this case the Examiner has not show that Steiner or Chidlovskii "suggests the desirability of the alleged combination."

Examiner Responds:

Examiner is not persuaded. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

**available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated, a frequency of appearance into the system of Steiner. It would have been obvious to incorporate a frequency of appearance into the system of Steiner because as stated before the more an information name appears, the assumption is that information item is more item to the provider. (Smith, III, col. 2, lines 30-32).

In response to applicant's argument on pages 4 and 6, a *prima facie case of obviousness* is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leon J. Harper whose telephone number is 571-272-0759. The examiner can normally be reached on 7:30AM - 4:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LJH  
Leon J Harper  
June 7, 2006

  
MOHAMMAD ALI  
PRIMARY EXAMINER